

III. REMARKS

1. Claims 1 , 6 and 7 are amended.

2. Claims 1, 3, 4, 6, 7 and 9-11 are not unpatentable over Carter et al. ("Carter"), U.S. Patent No. 5,909,540 and further in view of Fleischman et al. ("Fleischman"), U.S. Patent No. 5,2196,934 under 35 U.S.C. §103(a).

Claim 1 is amended to recite that the method involves displaying a functional representation of the Web page. In Applicants' invention, the Web page is scaled down while preserving functional information, such as clickable links, dropdown menus, selection buttons etc. (page 7, lines 15-25). In Applicants' invention the original data (or HTML source code containing the functional information) remains available after the Web page is scaled down. Claim 7 has been similarly amended to make clear that the device is capable of displaying a functional representation of the Web page. In other words, Applicants' invention resizes both text-based data from HTML pages and embedded images contained in many Web pages, as described on page 7, lines 21-25 in the specification. These features are not disclosed or suggested by Carter in view of Fleischman.

Carter relates to data storage systems that are reliable and fault tolerant. The system disclosed in Carter is capable of repairing errors encountered during operation because system data is distributed across network nodes. Nothing in Carter relates to displaying a functional representation of the Web page after the Web page is scaled down to fit on a smaller display than what was originally intended, or what the Web page was originally designed for.

Fleischman does not overcome this deficiency of Carter. Fleischman teaches an apparatus for scaling images for use in multimedia computer systems capable of presenting images presented in a portion of the screen of the display device i.e. windowed on the screen (Col. 1, lines 44-47). This enables e.g. a video presentation to run in a small window of the screen while other information can be shown in the wider area of the screen. Fleischman's method enables images to be scaled down to a smaller dimension by a process of "dropping" pixels. Similarly as in Carter, nothing in Fleischman relates to displaying a functional representation of the Web page after the Web page is scaled down to fit on a smaller display than what was originally intended, or what the Web page was originally designed for. Thus, neither Carter nor Fleischman displays a functional representation of the Web page and preserving the functional information when the Web page is scaled down. Therefore, since the combination of references does not disclose or suggest each feature of Applicant's invention as recited in the claims, particularly claims 1 and 7, a *prima facie* case of obviousness under 35 U.S.C. §103(a) cannot be established.

Furthermore, Applicants also respectfully submit that Carter makes no disclosure related to a handheld device. The Examiner correctly notes that Carter does not disclose "reading", "counting" and "removing" as described and claimed by Applicant. Fleischman does not overcome the deficiencies of Carter. The method disclosed in Fleischman is not suitable for use in displaying HTML-based Web pages within a browser window environment. This is because Fleischman merely resized images and does not preserve the functional information since there is no functional information in the images of Fleischman. There are no clickable links or text selection that enable user-interaction

in conventional Web pages in Fleischman. In other words, Fleischman's method merely results in a scaled down image of the Web page itself such that information required by a web browser would not be included, e.g., font information, input boxes, active selection buttons etc.

Thus, the combination of Carter and Fleischman does not disclose or suggest each feature of Applicants' invention as recited in claims 1 and 7.

Therefore, claims 1 and 7 should be allowable, with claims 3, 4, 6 and 9-11 at least being allowable in view of their respective dependencies.

3. Claims 2 and 8 are unpatentable over Carter, Fleischman and Bjork at least by reason of their respective dependencies on claims 1 and 7.

4. Claim 5 is not unpatentable over Carter, Fleischman and Hass et al. at least in view of its dependency on claim 1.

5. Applicants respectfully note that Carter and Fleischman have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Carter and Fleischman are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Carter nor Fleischman are in the same field as the Applicants' invention. Applicants' invention is directed to displaying markup language based Web pages on a handheld device. Carter relates to data storage systems that are reliable and fault tolerant. Carter does not relate to and makes no disclosure of a handheld device. Carter relates to data storage systems that are reliable and fault tolerant. The system disclosed in Carter is capable of repairing errors encountered during operation because system data is distributed across network nodes. These are not the same fields of endeavor as Applicants' invention. Similarly, Fleischman is not reasonably pertinent to the particular problem with which the Applicants were concerned. Applicants' invention is also directed to downloading markup language based pages designed for larger displays for viewing on handheld devices with relatively small displays. Fleischman is not reasonably pertinent to that problem. The method disclosed in Fleischman is not suitable for use in displaying HTML-based Web pages within a browser window environment. This is because Fleischman merely resized images and does not preserve the functional information since there is no functional information in the images of Fleischman. There are no clickable links or text selection that enable user-interaction in conventional Web pages in Fleischman. In other words, Fleischman's method merely results in a scaled down image of the Web page itself such that information required by a web browser would not be included, e.g., font information, input boxes, active selection buttons etc.

Thus, neither Carter nor Fleischman are in the same field of endeavor as Applicants' invention and neither Carter nor Fleischman are directed to the problem addressed by Applicants. Carter is simply directed to data storage while Fleischman

relates to image scaling using scaling parameters. Thus, Carter and Fleischman are not analogous art and may not properly be combined for purposes of 35 U.S.C. §103(a).

6. It is also submitted that neither of the references supplies the necessary and requisite motivation to establish obviousness under 35 U.S.C. §103(a). In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted previously above, Carter in view of Fleischman does not disclose or suggest each feature of Applicants' invention as claimed. Thus, at least for that reason a *prima facie* case of obviousness is not established.

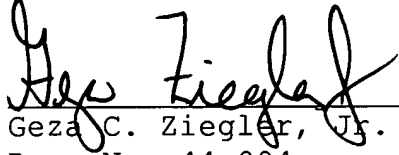
Furthermore, Applicants also submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Carter or Fleischman. Carter relates to data storage systems that are reliable and fault tolerant. The system disclosed in Carter is capable of repairing errors encountered during operation because system data is distributed across network nodes. Fleischman teaches an apparatus for scaling images for use in multimedia computer systems capable of presenting images presented in a portion of the screen of the display device i.e. windowed on the screen (Col. 1, lines 44-47). This enables e.g. a video presentation to run in a small window

of the screen while other information can be shown in the wider area of the screen. Fleischman's method enables images to be scaled down to a smaller dimension by a process of "dropping" pixels. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the reference as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Carter and Fleischman under 35 U.S.C. §103(a) is not established.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.

Reg. No. 44,004

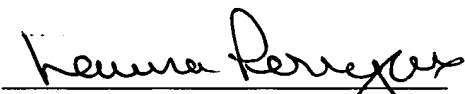
29 June 2004
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